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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,720	07/24/2001	James P. Hearn	8932-177	1799
51832	7590	07/27/2007		
JONES DAY			EXAMINER	
222 EAST 41ST STREET			RAMANA, ANURADHA	
NEW YORK, NY 10017-6702			ART UNIT	PAPER NUMBER
			3733	
			MAIL DATE	DELIVERY MODE
			07/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/910,720	HEARN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Anu Ramana	3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) Responsive to communication(s) filed on 24 April 2007.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,2,5-16,27,31-39,41,43-46,49,51-54,64,65,67,72,73,76,78-85 and 87-99 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 7/24/01 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

**Continuation of Disposition of Claims:** Claims pending in the application are 1,2,5-16,27,31-39,41,43-46,49,51-54,64,65,67,72,73,76,78-85 and 87-99.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 45-46, 49, 88-90 and 93-99 are rejected under 35 U.S.C. 102(b) as being anticipated by Marchesi (US 4,736,494).

Marchesi discloses a clamp including a first clamping member 23, a smooth extension member 21 extending from the first clamping member, a second clamping member 1 comprising a plurality of radial cutouts 2 and an integrally formed stop 22 for limiting movement of the second clamping member on the extension member (Figs. 1 and 2, col. 2, lines 16-68, col. 3 and col. 4, lines 1-58).

It is noted that a claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

Claims 1, 2, 5-11, 15, 27-36, 39, 41, 43, 45-46, 49, 51-54, 65, 67, 78-85, 87-90 and 93-99 are rejected under 35 U.S.C. 102(e) as being anticipated by Herrington et al. (US 6,379,363).

Herrington et al. disclose a cranial clamp having a smooth base or first clamping member 12, a head 30 disposed proximate first clamping member with a bore, a stem or "substantially smooth extension member" or "tube" 16 placed in the bore of head 30, a smooth cap or second clamping member 14 and an "integrally formed stop member" or "crimp" or "ridge" or "twisted portion" or "proximal flared portion" 32 which limits the movement of clamping member 14 on extension member 16 (Figures 1 and 21e, col. 4, lines 4-67 and col. 5, lines 5-31).

Herrington et al. also disclose second clamping member as having radial cutouts 54 extending inwardly from an outer circumference of the clamping member 14 (Fig. 3, col. 4, lines 59-64 and col. 5, lines 5-17).

Regarding claims 10, 35, 83 and 99, opening 59 includes a countersink or an "enlarged opening" (Figures 1 and 3).

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12-14, 16, 37-38, 44, 64, 72, 76, 91 and 92 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herrington et al. (US 6,379,363).

Herrington et al. disclose all elements of the claimed invention except for: (1) a fastener hole in the second clamping member; and (2) an extension member that is a ribbon or a longitudinal member with a rectangular cross section.

Regarding claims 12-14 and 76, although Herrington et al. do not disclose that extension member 16 is a ribbon or a longitudinal member with a longitudinal cross section, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute a ribbon for the extension member wherein so doing would amount to mere substitution of one functionally equivalent structure for another

within the same art, namely, a structure capable of being sheared off against a suitable surface, and the selection of any of these structures would work equally well in the claimed device.

Regarding claims 16, 44, 64 and 72, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided a fastener hole in the second clamping member for securing the clamping member since it is well known in the art to utilize fasteners for the purpose of securing one member to another.

### ***Response to Arguments***

Applicant's arguments submitted under "REMARKS" in the response filed on April 24, 2007 have been carefully considered.

Regarding the rejections of claims 1-2, 5-11, 15, 27-36, 39, 41, 43, 45-46, 49, 51-54, 65, 67, 78-85, 87-90 and 93-99 under 35 USC 102(e) over Herrington et al., it is noted that during examination, claims must be interpreted as broadly as their terms reasonably allow. This means that the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. *In re Zletz*, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). Since Applicants have not specified whether the extension member is substantially smooth on a macroscopic or a microscopic scale, Herrington et al. meets the claim limitations.

Regarding the rejections under 35 USC 102(b) of claims 45-46, 49, 88-90 and 93-99 over Marchesi, it is noted that if the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999). See also *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997) ("where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not

a claim limitation") ( per MPEP 2111.02). Thus, Marchesi clearly anticipates the invention as defined by the claims.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3733

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR

July 23, 2007



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